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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/844,790	04/26/2001	Michael D. Doyle	021117-000100US	1685

7590 09/30/2004  
Edward J. Radlo  
Fenwick & West LLP  
Two Palo Alto Square  
Palo Alto, CA 94306

EXAMINER


GYORFI, THOMAS A

ART UNIT	PAPER NUMBER
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2135

DATE MAILED: 09/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/844,790	DOYLE ET AL. 	
	<b>Examiner</b>	<b>Art Unit</b>	
	Tom Gyorfi	2135	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 2 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 2 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>7/5/02</u> . | 6) <input type="checkbox"/> Other: ____.  |

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1. Claims 1 and 2 have been examined.

### ***Double Patenting***

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1 and 2 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 09/844,066 in view of Ananda (U.S. Patent 6,671,813).

Claims 1 and 2 of the instant application contains all limitations taught in claim 1 of copending Application No. 09/844,066, except for "configuring a second server to request a cross-certification for a second interval so that the first server is effectively requested to provide independent proof of the existence of the interval and its public key at a point in time witnessed by the first server". Note that the specification of the copending application states that one may request a cross-certification, implying that this step is optional (Application 09/844066, page 6, lines 3-6). It would have been obvious to one of ordinary skill in the art at the time of the invention to omit that feature as part of the claimed invention of the instant Application, in order to obtain a broader scope for

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Applicant's claim, thus creating a genus-species relationship (*In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993)). Furthermore, the co-pending Application teaches neither "encoding certification information in graphical form to form an indicia that relates to the authenticity of the document", nor "decoding the indicia to authenticate a document". However, Ananda teaches a system for providing secure access and execution of application software between computers connected via a network. Specifically, the preferred embodiment of the Ananda disclosure is that of an on-line postage metering system, which is capable of encoding certification information (Ananda, column 26, line 62 to column 27, line 3) into graphical form to form a two-dimensional barcode (Ananda, element 1903 of Figure 19) that relates to the authenticity of the postage stamp (Ananda, column 27, lines 4-15, and element 1902 of Figure 19). Ananda also teaches the means by which the indicia can be decoded so as to verify that the postage information thusly encoded matches that which is plainly written on the envelope or package (Ananda, column 27 lines 16-22). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the abilities of graphically encoding certification information and decoding the graphical indicia into the invention disclosed by application 09/844,066. Given that barcode readers are a well known and commonly used technology, encoding this information into barcode form would have the result of providing a simple well-understood means of verifying the certified information while simultaneously being tamper resistant, as even a slight alteration in the barcode data would render it invalid.

This is a provisional obviousness-type double patenting rejection.

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***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Guski et al. (U.S. Patent 6,711,679), Doyle (PCT Patent WO 99/16209), and Ananda (U.S. Patent 6,671,813).

Regarding claim 1, Guski teaches a system to perform a serially chained certification process (Guski, column 3 line 57 – column 4, line 4) which comprises the steps of having a second server perform a cross-certification such that the first server must provide independent proof of its public key, in the form of the digital signature which only it could produce with a corresponding private key, at a point in time witnessed by the first server (Guski, Figure 3 and also column 7, lines 15-20); and also continuing the process to cross-chain an unlimited number of additional servers to form a widely witnessed web of digital signatures (Guski, Figure 4 and column 8, lines 9-20). It does not teach the use of time intervals and associated public/private key pairs as part of its certification process. However, Doyle teaches a system for creating irrefutable digital signature timestamps based on the notion of creating public and private key pairs for a number of time intervals. In particular, Doyle teaches the steps of creating a first interval certification at a server (Doyle, page 13, lines 8-12) and deleting

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the private key of the interval once the interval has expired (Doyle, page 6, lines 6-10 and also page 19, lines 26-27). It is also taught that the process can be repeated for additional intervals (Doyle, page 13, lines 15-16), creating a chain of irrefutable timestamps bearing witness to the interval of time thus certified (Doyle, page 19, lines 18-21). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include the concept of temporal intervals as part of the certification process taught by Guski, as well as using the public and private key pairs associated with said intervals as the keys used in the digital signatures contained in the certificates found in the Guski disclosure. Note that the intended purpose of the Guski disclosure was to improve the security of E-commerce transactions, particularly those conducted through the use of intermediaries (Guski, column 3, lines 3-22); by including accurate timestamps as found in Doyle, one can more easily detect a hacker attempting a replay attack against the system – if the timestamp in the certificate does not match that logged by the network hardware on the server, then the contents of the message could then be viewed as suspect.

Further regarding claim 1, note that the only components of the certificates explicitly taught by either Guski or Doyle are the server information (in the form of a server certificate), expiration date/stop time of the interval (Guski, column 7, lines 27-31), the public key of the interval and a digital signature of the submitted data, signed by the interval's private key (Doyle, page 13, lines 8-12 and also lines 18-20). The start time of an interval chain in UTC and the start time of the interval in UTC are not elements of the certificate taught by either reference. However, it would have been

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obvious to one of ordinary skill in the art at the time the invention was made to include those elements as part of the certificate. Possessing this information would make it easier for an authenticator to verify that the timestamp does indeed belong to the interval that signed it.

Further regarding claim 1, note that a digital signature for the interval signed by the previous interval's private key is not explicitly taught, although it should be noted that the public key representing the current interval is signed by the previous interval's private key (Doyle, page 18, lines 13-17). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include information about the current interval in the digital signature of the public key that is already included in the certificate. Since the intervals are well-defined units of time (Doyle, page 11, lines 4-5) and each interval begins when the previous interval ends, any given interval has enough information about the next interval to encode it with the public key signature; further, by including this information, one can be more certain that the public key supplied in the certificate does indeed belong to the new interval immediately succeeding the previous one, and that the key is not in fact a valid public key that was supplied out of sequence.

Further regarding claim 1 and also regarding claim 2, the combination of Guski and Doyle does not teach the limitations of encoding certification information in graphical form to form an indicia that relates to the authenticity of the document, nor decoding said indicia to authenticate said document. However, Ananda teaches a system for providing secure access and execution of application software between

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computers connected via a network. Specifically, the preferred embodiment of the Ananda disclosure is that of an on-line postage metering system, which is capable of encoding certification information (Ananda, column 26, line 62 to column 27, line 3) into graphical form to form a two-dimensional barcode (Ananda, element 1903 of Figure 19) that relates to the authenticity of the postage stamp (Ananda, column 27, lines 4-15, and element 1902 of Figure 19). Ananda also teaches the means by which the indicia can be decoded so as to verify that the postage information thusly encoded matches that which is plainly written on the envelope or package (Ananda, column 27 lines 16-22). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the abilities of graphically encoding certification information and decoding the graphical indicia into the invention disclosed by Doyle in view of Zabetian. Given that barcode readers are a well known and commonly used technology, encoding this information into barcode form would have the result of providing a simple well-understood means of verifying the certified information while simultaneously being tamper resistant, as even a slight alteration in the barcode data would render it invalid.

### ***Conclusion***

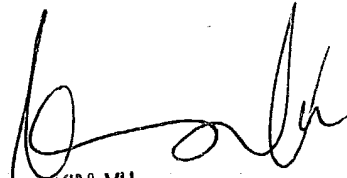
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tom Gyorfi whose telephone number is (571) 272-3849. The examiner can normally be reached on 8:00am - 4:30pm Monday - Friday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on (571) 272-3859. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TAG  
09/27/04

  
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